



MADRID SYSTEM

JIPO as the Office of Origin & Office of a CP of the Holder

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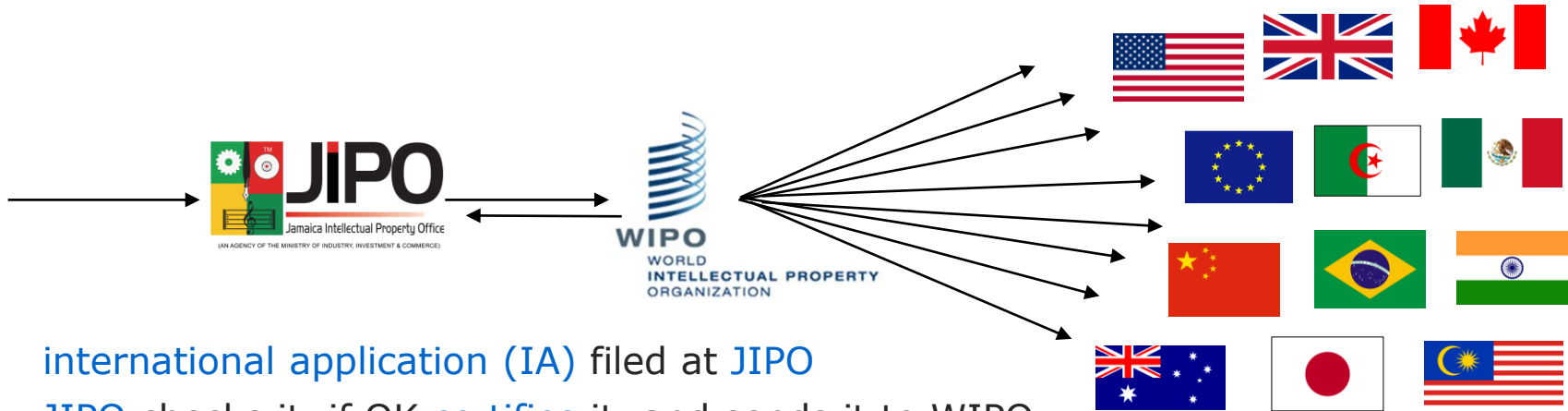
EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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JIPO as the Office of Origin

- Advise to applicants
- IA certification, processing irregularities
- Ceasing of effects of the basic mark

PROCESSING INTERNATIONAL APPLICATIONS (IA)



- international application (IA) filed at JIPO
- JIPO checks it, if OK certifies it, and sends it to WIPO
- WIPO notifies back any irregularity for rectification
- whenever an IA is correct, WIPO registers the mark, publishes the international registration (IR) and notifies the designated Contracting Parties (DCPs)

WHO IS ENTITLED TO FILE AN INTERNATIONAL APPLICATION (IA) AT JIPO ?

Madrid Protocol Art. 2 – Whoever has

- an attachment to Jamaica
 - nationality, or
 - domicile, or
 - real and effective industrial or commercial establishment
- and
- a basic mark in Jamaica
 - a TM application or a TM registration at JIPO

FILING THE INTERNATIONAL APPLICATION (IA) AT JIPO

MM2 Form (in English)

Filing methods – 111 Offices

- Paper form (<http://www.wipo.int/madrid/en/forms/>) – 93 Offices
 - MM2 filled out manually once downloaded as .doc, .pdf or as an **editable .pdf**
 - MM2 e-version filled out with the help of the **Madrid Application Assistant**
 - in respect of Offices giving access to their own TM data to WIPO
- Online filing – 33 Offices
 - through **Madrid e-Filing** – 15 TM Offices have adopted this tool
 - through a specific **e-filing service of the Office of Origin** (18 Offices)

Mandatory content ...

- name of the applicant and contact details
- reproduction of the mark
(according to Madrid standards & identical to the basic mark)
- list of goods & services
(covered by the basic mark)
- list of designated Contracting Parties (DCPs)

... having an impact on the date of the IA (Rule 15)

Other mandatory content ...

- entitlement to file
- address and e-mail address of the applicant
- name, address and e-mail address of representative, if appointed
- number and date of the basic mark in Jamaica
- priority claim, if applicable
- indications of the mark (kind of mark, colour claim)
- transliteration of the mark, if applicable
- amount of the fees paid and method of payment

Special, requirements by certain DCPs ...

- if the European Union (EM) is designated
 - 2nd language for opposition and cancellation proceedings before the EUIPO (**mandatory**) – to be indicated in **MM2**
 - seniority claim in the European Union (**optional**) – **MM17**
- if the United States is designated
 - declaration of intention to use the mark in the USA (**mandatory**) – **MM18**

Optional content ...

- nationality of the applicant (if a natural person)
- legal nature and State of incorporation (if a legal entity)
- translation of the mark, if possible
- voluntary description of the mark
- an indication in words of the principal parts of the mark which are in colour, where colour is claimed
- disclaimer

... recommended in respect of some DCPs

GOODS & SERVICES IN THE INTERNATIONAL APPLICATION

- Important to make sure that the goods & services
 - are covered by the list in the basic mark
 - are not expressed in terms that are too vague, linguistically incorrect or incomprehensible
 - are correctly classified according to the International Classification
- Best practice – recommend the use of online classification tools

TMclass

<http://euipo.europa.eu/ec2/>

terms accepted by 89 TM Offices from around the world

MGS

<https://webaccess.wipo.int/mgs/>

59,000 standard terms accepted by WIPO and checked by 40 Madrid Union Offices

JIPO shall check that

- the applicant is entitled to file the IA at JIPO – **Article 3**
 - JIPO may ask for proof or simply rely on the applicant's claim
- how certain data in the IA relate to the **basic mark** – **Rule 9**
 - applicant must be **the same** as the applicant or holder of the basic mark
 - mark in the IA must be **identical** to the basic mark
 - goods & services in the IA must be **covered** by those in the basic mark
- if IA contains **limitations of the g&s list in respect of one/more DCPs**
 - no limitation does in fact broaden the scope of the list of g&s in the IA

JIPO shall also check that

- the following **indications regarding the mark** only appear in the IA, if they also appear in the basic mark
 - that the mark consists of a **colour or combination of colours as such**
 - that the mark is a
 - a three-dimensional mark
 - a sound mark
 - a collective, certification, or guarantee mark

JIPO shall also check that

- if the **basic mark** (application or registration) contains a **colour claim**
 - the **same claim** is included in the IA as a distinctive feature of the mark
 - as from Feb 2023, if the **basic mark** is **protected or applied to be protected in colour**, even if it does not contain a colour claim as such, JIPO shall check that **the IA contains a colour claim**
- if the **IA contains a colour claim but not claimed in the basic mark**
 - JIPO shall check that the **basic mark is in fact in the colour or combination of colours claimed**

JIPO – IA CERTIFICATION

Following the examination of the IA

- if any elements are missing or not correct, JIPO shall invite the applicant to rectify the IA, which may otherwise be considered abandoned
- if everything is correct, JIPO shall certify the IA and forward it to WIPO indicating the date on which the IA was received at JIPO
 - JIPO should forward IA without delay (may have an impact on the IR date)
 - ideally, the IA should be sent to WIPO electronically
 - JIPO and IB may agree on a method for e-communication – A.I. Section 6(b)
 - possibly through the Madrid Office Portal

WIPO – EXAMINATION OF THE INTERNATIONAL APPLICATION

WIPO will check that

- there are no elements missing in the IA
- the terms used to indicate goods & services are not too vague, linguistically incorrect or incomprehensible
- the goods & services are correctly classified
- the fees have been paid

If there is an irregularity,

- WIPO will give the applicant or JIPO (depending on the case) a period to remedy the irregularity, failing which the IA will be considered abandoned

IRREGULARITIES TO BE REMEDIED BY JIPO

Three types of irregularities to be remedied by JIPO

- regarding the **classification of goods & services** - Rule 12
- regarding the **indication of goods & services** - Rule 13
terms too vague, linguistically incorrect or incomprehensible
- **other irregularities** - Rule 11
 - one or more elements are missing (applicant's name, contact details, entitlement, DCPs, list of G&S, date and number of basic mark, reproduction of the mark, certification by JIPO)
 - inconsistencies regarding the entitlement of the applicant
 - application not presented in the MM2 form or not signed by JIPO
 - MM18 form missing (when US is designated)

IRREGULARITY RULE 12 – GOODS & SERVICES CLASSIFICATION

IB sends to JIPO its own classification proposal (+ any fee adjustment)

– 3-month time limit for JIPO to reply

- **JIPO replies** – three possibilities
 - IB withdraws its proposal = mark **registered** as filed (no additional fees are due)
 - IB accepts JIPO's proposal (+ any due fees paid) = mark **registered** as per JIPO's proposal
 - IB confirms its own proposal (+ any due fees paid) = mark **registered** as proposed by IB
- **JIPO does not reply**
 - mark **registered** as proposed by IB (provided that any due fees are paid)
- **If due fees are not paid or amount is insufficient**
 - **application considered abandoned**

THE IB OPINION ON CLASSIFICATION ALWAYS PREVAILS - Article 3(2), Rule 12(9)

IRREGULARITY RULE 13 – GOODS & SERVICES INDICATION

If a term is considered too vague, incomprehensible or linguistically incorrect, IB may suggest to JIPO a substitute term or its deletion

– 3-month time limit for JIPO to reply

- JIPO agrees to IB's suggestion
 - = mark registered as per IB's suggestion
- JIPO makes an alternative proposal accepted by IB
 - = mark registered as per JIPO's proposal
- JIPO does not reply or makes a proposal not accepted by the IB
 - if term is classified = mark registered with original IA term, and annotation from IB
 - if term is not classified = mark registered but the term is deleted

RULE 11 – OTHER IRREGULARITIES TO BE REMEDIED BY JIPO

IB notifies JIPO – missing data, entitlement, form, signature

– 3-month time limit for JIPO to remedy irregularity [shorter period if it concerns MM18]

- JIPO remedies irregularity = mark registered
- No reply from JIPO or irregularity not remedied = IA considered abandoned
- Irregularity concerns missing or incorrect MM18 (US)
 - If corrected MM18 is received within 2 months from date of receipt of IA at JIPO = mark registered with designation of the US
 - If correct MM18 not received within 2-month period = US designation considered withdrawn

RULE 11(2)(a) – IRREGULARITIES TO BE REMEDIED BY THE APPLICANT

Any other than those to be remedied by JIPO

– 3-month time limit for the applicant to remedy the irregularity

For example

- no fees have been paid
- amount of fees paid is insufficient
- reproduction of the mark is not sufficiently clear
- IA contains a colour claim but no colour reproduction
- an address is incomplete
- indications concerning priority claim are not sufficient

JIPO will be informed but not required to do anything

INTERNATIONAL REGISTRATION (IR) AT WIPO

If there are no **irregularities** (or if these have been remedied)

WIPO will

- **register** the mark in the International Register
- **publish** the international registration (IR) in the WIPO Gazette of International Marks
- **notify** the IR to the designated Contracting Parties (**DCPs**)
- **inform JIPO**
- **send IR certificate** to the right holder

DATE OF THE INTERNATIONAL REGISTRATION (IR)

- date of receipt at JIPO
 - if received by WIPO within 2 months from date of receipt at JIPO
- date of receipt by WIPO
 - if received from JIPO later than two months
- date of receipt by WIPO of the last missing element
 - if certain elements are missing:
 - applicant's name and contact details
 - one or more designated Contracting Parties (DCPs)
 - a reproduction of the mark
 - indications of goods & services

Ceasing of effects of the basic mark

- For a period of **5 years from the date of the IR**, the protection resulting from the IR shall remain dependent on the basic mark in Jamaica (basic registration, basic application, or the registration resulting therefrom) – **Protocol Art 6(3) & (4)**
- If during that **dependency period** (or as a result of an action commenced within that period), **the basic mark in Jamaica ceases to have effect**
 - because the basic application or registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation
 - in respect of all or some of the goods and services listed in the IR**the protection of the IR will be restricted accordingly**

- The expression “**ceasing of effect**” of the basic mark has a broader meaning than the expression “**central attack**”. The ceasing of effect does not always result from an action (“attack”) from a third party.
- If the basic mark ceases to have effect, **JIPO shall**
 - **notify the IB** of the relevant facts and decisions affecting it, and
 - **if the decision is final shall request the cancellation of the IR**
- Where **only some G&S are affected**, the notification by **JIPO** shall indicate which goods & services are affected or which are not affected

- For requesting the **cancellation** of an IR, **JIPO** may use **Model Form 9**, which can be downloaded from:
https://www.wipo.int/madrid/en/contracting_parties/model_forms.html
- JIPO should not send a request for cancellation until it is clear that there is no possibility of the ceasing of effect being reversed
- But, **if JIPO is aware that, at the end of dependency period certain actions are pending** that may result in the ceasing of effect of the basic mark, **it shall notify the IB accordingly** asap (it should make clear that the action in question has not yet resulted in a final decision) – **Rule 22(1)(b)**

- Pending proceedings that **JIPO** shall notify :
 - any judicial action concerning the basic registration
 - any appeal against a decision refusing the basic application
 - any action requesting withdrawal of the basic application
 - any opposition to the basic application
 - any action requesting the revocation, cancellation or invalidation of the basic registration or of the registration resulting from the basic application
- **Final decision** – As soon as **JIPO** becomes aware that a final decision has been taken regarding those pending proceedings, **JIPO shall notify the IB accordingly and shall request the cancellation of the IR to the extent applicable – Rule 22(1)(c)**

- If JIPO requests the cancellation of the IR because of the basic mark has ceased to have effect, the IB shall cancel the IR in the International Register
- IB shall also cancel any IR resulting from a partial change in ownership or division of the canceled IR, as well as any IR resulting from their merger
- The cancellation of the IR shall be published in the Gazette
- Any notification by JIPO that an action begun before the end of the five-year dependency period is still pending at the end of that period, will also be published in the Gazette

- If the **basic mark** (application or registration) in Jamaica is **divided**, or if several basic applications or basic registrations are **merged** in Jamaica, **during the 5-year dependency period, JIPO shall notify the IB accordingly – Rule 23**
- The notification of division or merger of the basic mark is **recorded** in the International Register, **published** in the Gazette, and **notified** to the DCPs and the IR holder
- Such **information is particularly pertinent in cases of third-party central attack**

JIPO as the Office of a Contracting Party of the Holder

OFFICE OF A CONTRACTING PARTY OF THE HOLDER (OCPH) – Rule 1 (xxvibis)

Office of a Contracting Party of the holder (OCPH) – Rule 1(xxvibis)
means ...

- the Office of Origin
- or
- where a change in ownership has been recorded ...

... the Office of a Contracting Party in respect of which the holder fulfils the conditions to be the holder of an international registration (IR)

JIPO AS THE OCPH MAY HAVE A ROLE TO PLAY IN RESPECT OF ...

- Subsequent designations - [Rule 24](#)
- Change in ownership - [Rules 25 to 27](#)
- Limitation, renunciation, cancellation - [Rules 25 to 27](#)
- Changes in name, address or legal nature – [Rules 25 to 27](#)
- Division and merger of international registrations – [Rule 27bis](#), [Rule 27ter](#)
- Corrections concerning an international registration – [Rule 28](#)
- Licenses – recording, amendment, cancellation – [Rule 20bis](#)
- Restrictions of the holder's right of disposal – [Rule 20](#)

The holder of an IR may extend its protection to one or more CP through a SD

- **MM4** -> indicating the IR number, new DCPs, goods & services (within the scope of the IR), special requirements by some DCPs (US, EM) and paying relevant fees

If JIPO is the Office the holder (OCPH), the holder may present the SD either

- through JIPO - **MM4** or
- directly to WIPO - **MM4** or through **Online SD** web service

Several OCPHs encourage holders to submit their SD requests directly to WIPO

If SD presented through JIPO: the **SD date** will be the date of receipt by JIPO, provided that the IB receives it within 2 months and there are no irregularities or these have been remedied

SD possible later date: if it contains a request to take effect immediately after another event (e.g., renewal, change)

CHANGE IN OWNERSHIP – RULES 25 to 27

A request to record a change in ownership of an IR

- total or partial, in respect of one or more DCPs
- must be presented to WIPO in MM5, either
 - by the holder or
 - by the Office of the holder or
 - by the Office of the transferee

The request **must** be presented through an Office

- where the recorded holder no longer exists (e.g. due death or bankruptcy)

When presented through JIPO (as Office of the holder or Office of the transferee)

- JIPO may require evidence concerning the change in ownership
- but no supporting documents shall be sent to IB (e.g. contract, deed of assignment)

LIMITATION, RENUNCIATION, CANCELLATION – RULES 25 to 27

An IR may be subject of a voluntary limitation, renunciation or cancellation

- request may be presented by the holder directly to WIPO or through JIPO (as OCPH)
- **Limitation – MM6**
 - removes some goods & services in all or some DCPs
 - those goods & services remain in the IR and may be the subject of SD
- **Renunciation – MM7**
 - abandons all the goods & services in some DCPs
 - the goods & services remain in the IR and may be the subject of SD
- **Cancellation – MM8**
 - cancels the effects of the IR for all/some goods & services in respect of all DCPs
 - goods & services are definitely removed from the IR (SD no longer possible)

CHANGES IN NAME, ADDRESS OR LEGAL NATURE – RULES 25 to 27

Change in name or address of the holder

- may be presented directly to WIPO or through [JIPO \(as OCPH\)](#) – MM9

Change in legal nature of the holder (legal entity)

- may be presented directly to WIPO or through [JIPO \(as OCPH\)](#) – MM9
- shall indicate the new legal nature and the State where the entity is organized

Change in name or address of representative

- may be presented directly to WIPO or through [JIPO \(as OCPH\)](#) - MM10

CORRECTIONS – RULE 28

- WIPO may correct an error in the IR
- *ex officio* or
 - upon request by JIPO or holder - MM21
- Error attributable to JIPO
 - the request must be made by the holder or by JIPO
 - if the correction would affect rights deriving from the IR, the error may be corrected only if the request is received by the IB within 9 months from the date of publication of the erroneous entry in the International Registry
 - Error made by WIPO – no time limit for requesting correction
 - Mistakes by the applicant, holder or representative – cannot be corrected

LICENSES – RECORDING, AMENDMENT, CANCELLATION – RULE 20bis

Requests for recording, amendment or cancellation of a license in the International Register, may be presented

- directly to the IB, or
- *if JIPO so admits*, through JIPO (as OCPH or as the Office of the CP with respect to which the license is granted)
- Recording - MM13
 - effects in up to 93 DCPs (27 CPs do not recognize such effect)
 - sublicense cannot be recorded
- Amendment - MM14
- Cancellation - MM15

RESTRICTION OF THE HOLDER'S RIGHT OF DISPOSAL – RULE 20

A restriction of the holder's right of disposal

- may result *e.g.*
 - from a court order concerning the disposal of the assets by the holder, or
 - from the fact that the IR has been given as security
- may concern all or some DCPs

JIPO (as OCPH)

- *may* inform the IB of such a **restriction** - MM19
 - provide a summary statement of the main facts
 - specify if the restriction concerns only some DCPs
 - no copies of court decisions or deeds should be attached
- *shall* inform the IB of any partial or total removal of the restriction



THANK YOU



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